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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,556	12/12/2005	Manlio Gallotti	2002DE442	4698

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CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

NWAONICHA, CHUKWUMA O

ART UNIT PAPER NUMBER

1621

MAIL DATE DELIVERY MODE

06/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/537,556	Applicant(s) GALLOTTI ET AL.	
	Examiner Chukwuma O. Nwaonicha	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Current Status

1. This action is responsive to Applicants' amendment of 26 March 2007.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Claims 1-6 and 8-15 are under active consideration in the instant application.
4. The Objection of claims 8-15 is withdrawn in favor of a new rejection.

The rejection of claims 1-6 under 35 U.S.C. 103 as being unpatentable over Smith et al., {US 5,414,124} for the reasons set forth in the previous Office Action of 01/12/07 is maintained. Applicants' amendments filed 26 March 2007 have been fully considered but they are not persuasive because applicants claimed composition still reads on the prior art of Smith et al. when the component in the presently claimed composition reads a quaternary ammonium composition consisting essentially of a) a cationic compound, b) less than 20% by weight of water based on said composition and c) a non-ionic solvent selected from the group consisting of an alcohol or an ethoxylated alcohol and mixtures thereof. Smith et al. teach a quaternary ammonium compound solution comprising from about 50% to about 80% of a quaternary ammonium compound and from about 5.0% to about 50% alkylene glycol with the remainder being water. See the claims in US 5,414,124. The different between the prior art reference and the presently claimed invention do not constitute a patentable distinction because Smith et al. teach the elements of the claimed invention with sufficient guidance, particularity, and with a reasonable expectation of success, that the invention would be *prima facie* obvious to one of ordinary skill in the art.

New Rejections

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 provide for the process of making quaternary ammonium composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a process without any active, positive steps delimiting how this use is actually practiced.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed recitation of a method of making quaternary ammonium composition, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

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ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

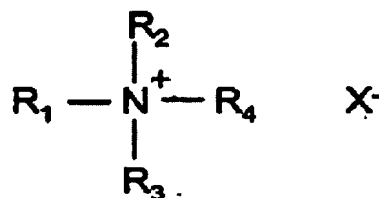
USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gunter, {US 4,675,180}.

Applicants claim a process for making quaternary ammonium composition essentially of a cationic compound of general formula 1; wherein all the variables are as defined in the claims.

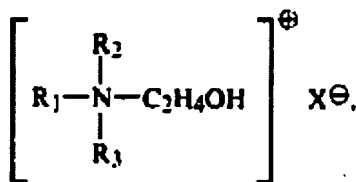


formula 1

Determination of the scope and content of the prior art (M.P.E.P. §2141.01)

Gunter teaches quaternary ammonium compounds of the formula 2 in which R_1 is long-chain alkyl, R_2 and R_3 are each lower alkyl and X^- is an anion, are prepared by quaternizing amines of the formula $R_1 R_2 R_3 N$ with ethylene oxide in the presence of inorganic acid. This gives the quaternary compounds in virtually quantitative yield.

The compounds are particularly suitable for use in hair cosmetics.



Formula 2

Ascertainment of the difference between the prior art and the claims (M.P.E.P. §2141.02)

Applicants process for making quaternary ammonium compounds differs from that of Gunter process in that applicants claim a process that employs wherein R₁ and R₂ are C₁-C₂₂ alkyl while Gunter employed a process wherein R₁ and R₂ are C₁-C₄ alkyl.

Finding of prima facie obviousness--rational and motivation (M.P.E.P. §2142-2143)

The instantly claimed process for making quaternary ammonium composition would have been suggested to one of ordinary skill because one of ordinary skill wishing to obtain quaternary ammonium composition is taught to employ the process of Gunter.

One of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention by varying the process conditions and the substituents on the nitrogen to arrive at the instantly claimed process for quaternary ammonium composition. Said person would have been motivated to practice the teaching of the reference cited because it demonstrate that quaternary ammonium composition have immense commercial applications. The Examiner notes that replacing one material in a composition with another material is a well-known technique in a chemical formulation

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to optimize the efficiency of the system and does not constitute a patentable distinction. Additionally, merely modifying the process conditions such as temperature and concentration is not a patentable modification absent a showing of criticality. In re Aller, 220 F.2d 454, 105 U. S. P. Q. 233 (C. C. P. A. 1955). Therefore, the instantly claimed invention would therefore have been obvious to one of ordinary skill in the art.

No Claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

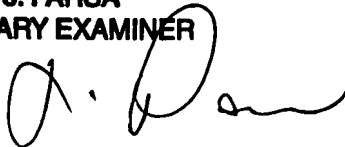
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Chukwuma O. Nwaonicha, Ph.D.
Patent Examiner
Art Unit: 1621

J. PARSA
PRIMARY EXAMINER

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